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No. 80-546

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1980

STUDIENGESELLSCHAFT KOHLE m.b.H., as Trustee for the Max-Planck-Institut fur Kohlenforschung,

Petitioner,

vs.

EASTMAN KODAK COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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Question Presented

Whether the scope of a patent directed to a polymerization catalyst may be interpreted in light of the reaction sought to be catalyzed.

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RESPONDENT'S BRIEF IN OPPOSITION

Eastman Kodak Company hereby opposes the petition for writ of certiorari to review the judgment of the Fifth Circuit Court of Appeals in the above matter.

Statement of the Case

The trial of the present action involved four patents, all directed to so-called "Ziegler catalysts" and processes for using them. Two of these patents were held invalid and not infringed (U.S. patent Nos. 3,231,515 and 3,392,162), and no appeal was taken from this ruling. Two other patents, U.S. patent Nos. 3,257,332 (the '332 patent) and 3,826,792 (the '792 patent), were found not to be infringed by defendant, and this conclusion was affirmed by the Fifth Circuit Court of Appeals.

The present petition concerns only the '332 patent, which is entitled "Polymerization of Ethylene". The scope of the '332

patent was extensively considered in the earlier litigation of *Ziegler* v. *Phillips Petroleum Co.*, 483 F. 2d 858 (5 Cir.), *cert. denied*, 414 U.S. 1079 (1973) in which action the present petitioner moved to be substituted as party-plaintiff as successor in interest to Karl Ziegler, who died.

Petitioner here states that the claims of the '332 patent are "composition of matter claims" (PB 4, fn.).* However, in *Phillips* the Fifth Circuit found that the claimed subject matter was a catalyst having *both* composition of matter and process characteristics (483 F. 2d at 873), noting that a catalyst by its very nature must be defined in terms of the reactions catalyzed.** (*Ibid*) After a thorough analysis, the court in *Phillips* concluded that the scope of the '332 patent, even giving it "pioneer" status, did not extend to a catalyst for polymerizing any monomer other than ethylene and, specifically, not the monomer butadiene. (*Id.* at 874-75) Petitioner, as plaintiff in the *Phillips* case, took no steps there to seek rehearing or any further review of the conclusions of the Fifth Circuit.*** Similarly, in the present action, the Fifth Circuit, following the unchallenged principles set forth in *Phillips*, extensively reviewed the evidence and concluded that the '332 patent was limited to a catalyst for polymerizing ethylene and did not embrace a catalyst for polymerizing the monomer propylene. (PB, Appendix at pp. 32a-38a).

Defendant-respondent makes its accused catalyst by co-reacting three ingredients, each of which is essential to the catalytic

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* Petitioner's brief is referred to herein as "PB".

** The claims are not directed to simply a mixture of two chemicals, but rather to a catalytically active *product*, a polymerization catalyst, formed by mixing two active ingredients, at least one of which is present in an "effective amount". Therefore, the issue in *Phillips* and in this case was "catalyst" for what?; "effective amount" for what?

*** Petitioner here refers to these earlier conclusions in *Phillips* regarding the scope of the '332 patent, but seeks to dismiss them because the *accused* catalyst in that case is made differently than that involved here (PB at 4, fn. 3). However, the scope of the '332 patent, as any patent, is determined by the patent itself and its history, and is in no way dependent on the nature of *defendant's* product.

product: aluminum triethyl, lithium butyl and hydrogen reduced alpha titanium trichloride (PB, Appendix at pp. 52a-53a, 67a). Petitioner's Statement of the Facts (PB 5 and fn. 4) suggests that Kodak "makes" the '332 catalyst by combining aluminum triethyl with a titanium chloride compound, and that the court below ignored this "making" as an act of infringement. On the contrary, whether defendant "made" a catalyst having the composition called for by the patents in suit was a hotly contested factual issue below. The record is devoid of any evidence that defendant made the product formed by mixing the two components petitioner associates with the catalyst of the '332 patent (aluminum triethyl and a titanium chloride).* (See PB, Appendix at pp. 67a-70a, Findings of Fact 30-34 and 36).

Moreover, the Court of Appeals, after a careful factual analysis, affirmed the finding of the District Court that defendant did not make the composition of the catalyst of the '792 patent (PB, Appendix, pp. 51a-54a), which catalyst petitioner concedes is *identical* to that of the '332 patent.** Thus, although the Fifth Circuit did not specifically reach the "making" issue in connection with the '332 patent, it did reach the identical factual issue in connection with the '792 patent, and resolved it in favor of defendant. Petitioner here seeks no review of that conclusion.

Although petitioner lauds the successes of "Ziegler catalysts" and refers to "billions" of pounds of "plastics" made therefrom, it has failed to connect such alleged success with the particular patent at issue, or with the polypropylene plastic which is the sub-

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* At no time in the manufacture of its catalyst did respondent make a composition—even momentarily—that involved contacting aluminum triethyl with a titanium chloride compound *in the absence of* the essential third co-reactant, lithium butyl. We decline to extend the length of this brief by disputing the many other wholly irrelevant assertions of fact set forth at PB 5, fn. 4 which are at variance with the findings of fact.

** As Petitioner states at PB 3, "the '792 patent claims the process of using these [the '332 patent] catalysts . . ." See also, undisputed Finding of Fact 36 ("plaintiff contends that the catalyst of the '792 patent is the same as the catalyst of the '332 patent") (PB, Appendix, at p. 70a).

ject of this litigation. In fact, the record contains no evidence that even a single pound of commercial polypropylene plastic has been made using the catalyst of the '332 patent.

Reasons For Denying The Writ

The genesis of petitioner's present application resides not so much in the decision of the Fifth Circuit in the proceedings below as it does in the earlier decision of the Fifth Circuit in the case of *Ziegler* v. *Phillips Petroleum Co.*, supra, p. 2.

In *Phillips*, the Fifth Circuit specifically dealt with the very issues about which petitioner now complains: the protectable scope of the '332 patent and the nature of infringing activities under 35 U.S.C. § 271(a). At that time, the present petitioner acquiesced in the conclusion of the Court of Appeals and sought no review, a circumstance which undercuts the asserted importance of the questions presented here.* In the present case, the court below thoroughly reviewed the facts and law, and independently and correctly evaluated the scope of the '332 patent in line with established principles, including the principles set forth in *Phillips*. In doing so, as we point out below, the Fifth Circuit did not decide any issue of public importance or conflict. Nor has petitioner given any persuasive reasons why the thorough and straightforward review by the Fifth Circuit should again be reviewed by this Court.

I. The Issues Raised By Petitioner Were Not Raised or Considered In The Proceedings Below

Petitioner complains that the Fifth Circuit Court of Appeals in addressing the issue of infringement improperly construed the types of activity that would constitute infringement under 35 U.S.C. § 271(a). However, at no time during the contested proceedings below were these issues properly raised. As pointed out above, these issues were raised and considered in the earlier

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* In *Phillips* the petition for a writ of certiorari was filed by Phillips, not Ziegler.

Phillips case.* However, throughout the proceedings in the instant case, the petitioner, as plaintiff, did not urge to the District Court or the Court of Appeals that the court in *Phillips* used improper legal principles in construing the protectable scope of the '332 patent. On the contrary, petitioner adopted these principles and urged to the District Court and the Court of Appeals that, in light of these principles, the present defendant nonetheless infringed. Not until the Court of Appeals concluded there was no infringement did petitioner, in a Petition for Rehearing (which was denied), argue that these principles were wrong. Since the present issues were not duly considered or briefed in any of the contested proceedings below, it would be improvident to consider them now. See *United States* v. *Santana,* 427 U.S. 38, 41 n. 2 (1976); *Adickes* v. *Kress & Co.,* 398 U.S. 144, 147, n. 2 (1970); *California* v. *Taylor,* 353 U.S. 553, 557, n. 2 (1957); *Tyrrell* v. *District of Columbia,* 243 U.S. 1 (1917).

II. The Questions Presented, Even If Resolved In Petitioner's Favor, Would Not Change The Result Below

The Fifth Circuit Court of Appeals concluded that defendant's catalyst did not infringe the '332 patent because the '332 patent was limited to a catalyst for the polymerization of ethylene, and defendant's catalyst, irrespective of its composition, was used only for the polymerization of propylene, a significantly different reaction and monomer. (See Appendix, PB at 38a)

However, in connection with the infringement issue regarding the other patent in suit, the '792 patent, the Court of Appeals concluded that defendant's catalyst composition was not the catalyst composition claimed in the '792 patent (PB, Appendix at 51a-54a), which composition petitioner concedes is *identical* to that claimed in the '332 patent. Consequently, even if petitioner were correct in its assertions that the '332 patent should not have been limited to a catalyst for polymerizing ethylene, the petitioner is conclusively faced with the unappealed judicial determination

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* In *Phillips* the present petitioner relied on essentially the same authorities as it does in the present Petition.

that defendant's catalyst composition itself does not infringe the sole Ziegler catalyst composition which is the subject of the litigation. Therefore, irrespective of the outcome of the issues raised by the present Petition, the conclusion is inescapable that defendant would nonetheless be found to not infringe the '332 patent.

This Court has stated that its review should not be exercised if it would not affect the outcome of the litigation. *Sommerville* v. *United States,* 376 U.S. 909 (1964)*. See also *Belcher* v. *Stengel,* 429 U.S. 118 (1976) and *Flournoy* v. *Wiener,* 321 U.S. 253 (1943) and cases cited therein. As stated in *The Monrosa* v. *Carbon Black Export, Inc.,* 359 U.S. 180 (1959), at p. 184:

> ". . . While this Court decides questions of public importance, it decides them in the context of meaningful litigation. Its function in resolving conflicts among the Courts of Appeals is judicial, not simply administrative or managerial. . . ."

III. There Is No Conflict Between The Decision Below And Those Of Other Circuits

A. *The "All Uses" Theory*

Petitioner contends that the decision below is in conflict with other circuits respecting the proper interpretation of "composition of matter" claims (PB 5-6, 8-10).

Respondent disagrees. Petitioner overlooks the conclusions of the Fifth Circuit in the *Phillips* case, *supra,* respecting the nature of the claims here at issue. They are not pure "composition of matter" claims. Rather, they are directed to *catalysts* which have both composition of matter and process characteristics. The Fifth Circuit in *Phillips* properly pointed out that catalysts are unique compositions in that they are formulated to affect the rate and course of a given chemical reaction (483 F. 2d at 862). Consequently, the Court in *Phillips* was quite right in

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* In R. Stern & E. Gressman, *Supreme Court Practice* (5th Ed 1978) at p. 272, the *Sommerville* case is reported to have resulted in denial of the petition, despite conflict, because resolution would not change the result reached below.

noting that "different reactions require different catalysts"; that a "catalyst must be defined in terms of the reactions it catalyzes"; that the "use of a composition of matter chemical catalyst is an integral part of the definition of that particular catalyst"; and "that the proper construction of a patent claiming a chemical catalyst system, therefore, looks not only at the components of the system, but also at the reaction or reactions catalyzed and the products formed." (Id. at 873)* In following these principles, which were not challenged below, the court below made no error.

Since the claims at issue are catalyst claims, the facts of this case are totally unlike those represented by the cases which petitioner sets forth as the "conflicting" view. None of these cases involve the interpretation of claims directed to catalysts or any other composition having inherent process characteristics.**

Contrary to petitioner's assertion, the Fifth Circuit has not done away with the "all uses" theory purportedly exemplified by the distinguishable cases cited by petitioner; all it has done is note that when process characteristics clearly impinge on the

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* The scientific validity of these observations is well illustrated by the present case. Although the many examples of Ziegler catalysts set forth in the '332 patent are said to effectively catalyze ethylene into polyethylene, not one of them was shown to be capable of polymerizing propylene to polypropylene under the process conditions of defendant's plant. On the other hand, the accused catalyst was very effective in polymerizing propylene under the same conditions.

** *Radio Corp. of America* v. *Radio Engineering Laboratories, Inc.*, 293 U.S. 1 (1934) (claimed an electrical device, an oscillator); *Ansul Co.* v. *Uniroyal, Inc.*, 448 F. 2d 872 (2 Cir. 1971) *cert. denied*, 404 U.S. 1018 (1972) (claimed a *process* for treating plants; issue was adequacy of patent disclosure, not infringement); *Reinharts, Inc.* v. *Caterpillar Tractor Co.*, 85 F. 2d 628 (9 Cir. 1936) (claimed a machine, an auto-tractor); *King-Seeley Thermos Co.* v. *Tastee Freez Industries, Inc.*, 357 F. 2d 875 (7 Cir.) *cert. denied*, 385 U.S. 817 (1966) and *King-Seeley Thermos Co.* v. *Refrigerated Dispensers, Inc.*, 354 F. 2d 533 (10 Cir. 1965) (claimed a machine, an ice-maker; issue was inherent advantages, not unappreciated uses). *United Shoe Machinery Corp.* v. *O'Donnell Rubber Products Co.*, 84 F. 2d 383 (6 Cir. 1936) (claimed a machine for folding sheet material).

nature of the real invention, one cannot blindly apply an "all uses" concept.

Nor has the Fifth Circuit made any sweeping new law respecting claim interpretation, even in the rather narrow and esoteric area of catalysis. Significantly, the Court in the underlying *Phillips* case specifically cautioned that it was *not* setting down any sweeping rule preventing coverage of undisclosed uses:

> ". . . [W]e are not holding as a matter of law that the patentee of a chemical catalyst is protected in his monopoly only so far as he specifically claimed the reactions in which the catalyst finds use. That question is not before us. Rather, our specific task is to construe the '332 patent in a way that gives effect to the real invention, and nothing more or less. We acknowledge that a patentee should not be charged with foreseeing all of its possible uses [citation omitted], but where the patentee has evidently limited his claims to a particular use or has implicitly not claimed a particular use, then a proper construction of the patent must take such a limitation or exclusion into consideration". (*Phillips,* 483 F. 2d at 873)

By following these same principles the court below was hardly creating any diversity in the construction of 35 U.S.C. § 271(a). Indeed, in the seven years that have elapsed since the *Phillips* opinion was rendered, it has been oft-cited by other courts, but not once has it been referred to by these courts as having created any rule at odds with existing precedent.*

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* To the contrary, *Phillips* has been cited as traditional precedent for rules on infringement. See generally, *Swift Chemical Co.* v. *Usamex Fertilizers, Inc.*, —F. Supp.—, 197 U.S.P.Q. 10, 18 (E.D. La. 1977) ("The claims of a patent need not be limited solely to a device described in the specification or depicted in a drawing"); *Warbern Packaging Industries* v. *Cut Rate Plastic Hangers, Inc.*, —F. Supp.—, 200 U.S.P.Q. 616 (E.D.N.Y. 1978); *Rohm and Haas Co.* v. *Owens-Corning Fiberglass Corp.*, —F. Supp.—, 196 U.S.P.Q. 726, 744 (D. Ala. 1977) ("The claims of the patent are not, however, then restricted to the specific mode described in the specification").

B. *The Issue of "Making" the Catalyst*

Petitioner further asserts that the court below did not follow established precedent in failing to recognize that "making" a composition of matter is an independent act of infringement under 35 U.S.C. § 271(a) (PB 6-8). This argument ignores the fact, discussed fully above, that the invention of the '332 patent is a catalyst. None of petitioner's "making" cases (PB 7) involved a catalyst or any other analogous type product having process characteristics.

Moreover, petitioner here seeks to re-argue the factual issue of whether respondent actually makes the composition of the Ziegler catalyst. However, as we have noted, *supra*, p. 5, the court below, in connection with the companion '792 patent, resolved that issue against petitioner, and no appeal has been taken concerning it. Thus, there is no issue of "making" left to be resolved, even if the court below were incorrect in construing the '332 patent in light of the reaction catalyzed.

IV. No Important Question Is Presented

Petitioner makes gross speculations of the economic impact of the decision below which are wholly unwarranted. Petitioner's spectre of "enormous amounts of investment capital" relocating in the Fifth Circuit at the expense of other circuits in order to take advantage of the Fifth Circuit ruling is pure fantasy. (PB 5-6) In the first place, no conflict of views in fact exists (*supra*, pp. 6-8). Moreover, the nature of venue in patent matters (28 U.S.C. § 1400(b)) makes it unlikely that any particular industry—even if located in the Fifth Circuit—would be immune from suit in other circuits.

Conclusion

The present Petition does not set forth compelling or even well founded reasons for review. For the reasons stated herein the Petition should be denied.

Respectfully submitted,

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